

REMARKS

The application is believed in condition for allowance for the reasons set forth below.

Claims 1-20 are pending in the application.

Claim 17 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for having non-equivalent alternatives. This rejection is respectfully traversed.

MPEP 2173.05(h) states that elements that are so related as to constitute a proper Markush group may be recited alternatively.

Claim 17 recites alternative common geometric shapes that are readily discernable by one of ordinary skill in the art as related.

Moreover, MPEP 2173.01 provides that alternative expressions may be used as long as the boundaries of the claim are clear.

Claim 17 includes four alternatives. The claim recites what the alternatives are so as to establish boundaries that are clearly defined.

Accordingly, since claim 17 distinctly claims the subject matter that applicant regards as the invention, the 35 USC §112, second paragraph rejection is believed improper and should be withdrawn.

Claims 1-5, 8-15 and 18-20 were rejected as unpatentable over MORAND 5,833,169 in view of TRAMONTINA

6,502,781. That rejection is believed to be untenable for at least the following reasons.

First, the motivation of reducing friction offered in the Official Action for combining the references is inconsistent with the teachings of the references.

TRAMONTINA teaches two projections 50, 55 that are inserted into respective indentations 27, 66 of the roll 26 as seen in Figures 9 and 16. The projections 50, 55 are spring biased toward the roll 26 using springs 51, 54. The two biased projections rubbing against the roll creates a relatively large amount of friction on the roll 26.

In contrast, MORAND teaches a single projection having a base 11 that freely spins on support rim 21 (see Figure 5) and has minimal friction based on a plastic (base) to plastic (rim) interaction.

Since the plastic-to-plastic arrangement of MORAND produces less friction than the two biased projections rubbing against the roll in TRAMONTINA, using the teaching of biased projections against a roll as taught by TRAMONTINA in the device of MORAND would increase friction, not decrease friction, as cited for the motivation for combining the references.

Accordingly, one would not have been motivated to make the proposed combination.

Second, the references are so technologically different, one of ordinary skill would not have been motivated to combine the references in the manner suggested.

MORAND is directed to a cored roll, while TRAMONTINA is directed to a solid roll having indentations for projections.

A stubby projection (of TRAMONTINA) that inserts into an indentation (or even a core) would not work in the device of MORAND. See Figure 2 of MORAND wherein the spindle 7 extends through the roll to support the roll on the mount 5, before the cover 51 is closed.

It appears that a spindle that rotates through the roll as taught by MORAND is necessary for the device of MORAND to operate and replacing this spindle with plural stubby projections that minimally project into the roll would at best change the principle of operation of MORAND, but would more likely render MORAND inoperable. See *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), which teaches that if the proposed combination of references changes the principle of operation of a device, the combination is not sufficient to render the claims *prima facie* obvious.

Moreover, modifying MORAND in the manner suggested would change the principle of operation of MORAND with respect to how the cover of MORAND is used and the roll of material that is used. Column 4, lines 28-31 of MORAND teach that the free end 18 of the spindle 7 extends through a hole in the cover. Column 2,

lines 60-62 of MORAND teach that the free end 18 is shaped to provide a turning knob.

Having a projection on the cover would neither enable the spindle to come through the cover nor enable the spindle, and thus the roll, to be turned. Having a solid roll would not allow the spindle to come through the roll. Therefore, the proposed combination of references would change the principle of operation of MORAND, and thus the combination is not sufficient to render the claims *prima facie* obvious.

In addition, claims 3, 11, 15 and 19 provide that the roll support projection has a projection part that is adapted to penetrate into (pierce) a center of the roll. *The American Heritage Dictionary of the English Language, Fourth Edition* defines penetrate as "To enter or force a way into; pierce."

In contrast, TRAMONTINA teaches projections 55 that engage a preformed indentation or space in the side of the paper roll as disclosed on column 2, lines 27-30, of TRAMONTINA. Accordingly, the projections 55 of TRAMONTINA do not pierce the center of the roll. Rather, they rest in preformed indents or spaces formed in the roll.

Claims 4 and 12 provide that the projection part has a pointed end and a tapering shape. As seen in Figure 3 of TRAMONTINA, the end of the projection part 50 is rounded. In fact, TRAMONTINA could not have a pointed end because such pointed end would not allow insertion of the roll.

As seen in Figure 15 of TRAMONTINA, the roll is inserted from the bottom of the housing until the projections 55 align with the indents 27 in the roll. Having a pointed end would cause the roll of TRAMONTINA to be damaged during insertion or would entail premature insertion, such that the projections do not mate with the indentions as taught by TRAMONTINA. Accordingly, one would not choose a pointed end for the projection part of TRAMONTINA.

Claims 16 and 17 are rejected as unpatentable over MORAND in view of TRAMONTINA and further in view of HARRIS et al. 5,501,415. This rejection is respectfully traversed.

HARRIS is cited for the teaching of a projection having a pointed end and a tapering shape.

However, the teachings of HARRIS are totally unrelated to the present invention and thus would not have been relied upon to modify MORAND and TRAMONTINA.

As seen in Figures 1, 2 and 7 of HARRIS, the projection of HARRIS is pin 40 that is separate from the frame 60 and is first inserted into the sidewall 16 of bag 12. The pin 40 is then inserted into a preformed bore 72 in the roll of photographic web 14. The pin 40 has a flange 48 as seen in Figure 3 that allows the roll 14 to rotate on a frame 60.

Pin 40 of HARRIS is neither connected to a frame to hingedly rotate with the frame nor adapted to pierce a center of a solid roll of web material as recited in claim 15 (piercing the

photographic web 14 of HARRIS would destroy the web). Even if MORAND in view of TRAMONTINA were combinable, they do not teach or suggest what is recited in claim 15. Since claims 16 and 17 depend from claim 15 and further define the invention, the rejection of claims 16 and 17 is believed untenable. Reconsideration and withdrawal of the rejection are respectfully requested.

In view of the foregoing remarks, it is believed that the present application has been placed in condition for allowance. Reconsideration and allowance are respectfully requested.

Should there be any matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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